

REMARKS

By this amendment, Applicants have amended claims 17, 20, 24, 29, and 31 and added new claims 32-33. As a result, claims 12-33 are pending in this application. These amendments are being made to facilitate early allowance of the presently claimed subject matter. Applicants do not acquiesce in the correctness of the objections and rejections and reserve the right to pursue the full scope of the subject matter of the original claims in a subsequent patent application that claims priority to the instant application. Reconsideration in view of the following remarks is respectfully requested.

Initially, Applicants thank the Examiner for the courtesy extended to Applicants' undersigned representative during a telephone interview conducted on January 19, 2006. During the interview, the Office's interpretation of U.S. Patent No. 6,615,234 (Adamske) with respect to the "print file" of claim 12 was discussed. No exhibit was shown and no agreement was reached during the interview. The substance of the interview is included in the following remarks.

In the Office Action, claims 12-27 and 29-31 are rejected under 35 U.S.C. § 103(a) as allegedly being anticipated by Adamske. In order to establish a *prima facie* case of obviousness, the Office must show that (1) every feature is taught or suggested by Adamske; (2) Adamske or generally available knowledge suggests or motivates the modification(s); and (3) one would have a reasonable expectation of success. MPEP 2143. Because the Office fails to establish a *prima facie* case of obviousness, Applicants respectfully request withdrawal of the rejections of claims 12-27 and 29-31 for the following reasons.

With respect to claim 12, the Office fails to show, *inter alia*, that every feature of the claimed invention is taught or suggested by Adamske. For example, the Office alleges that

Adamske discloses the claimed generating a preview of a configured copy of the document on the server based on the print file and the configuration information. In support of its conclusion, the Office again cites column 5, line 64 through column 7, line 15 of Adamske as allegedly disclosing this feature. However, interpreting Adamske only for the purposes of this response, Adamske discloses creating web-viewable print preview files by converting the converted printable electronic document into a series of graphical preview images. (col. 6, lines 1-7). Subsequently, “[a]fter user 10 verifies the print preview, at operational screen 70 user 10 can select media options..., output handling options..., and destination(s)/recipient(s).” (col. 6, lines 58-62). Consequently, contrary to the Office’s assertion, Adamske fails to disclose, *inter alia*, the claimed generation of a preview based on anything other than the converted printable electronic document.

In response to similar arguments previously presented by Applicants, the Office apparently cites col. 6, lines 12-23 as allegedly disclosing configuration information. However, this portion of Adamske merely discusses that the document is previewed in JPEG format. Contrary to the Office’s apparent assertion, there is no mention of configuration information of any type in this portion of Adamske, and the conversion of a file from one format to JPEG format does not add any configuration information. As a result, Applicants respectfully request withdrawal of the rejection of claim 12 and claims 13-16, which depend therefrom, as allegedly being obvious in view of Adamske. Further, Applicants respectfully submit that claims 32 and 33, which also depend from claim 12 are allowable as presented. Alternatively, should the Office maintain its position that Adamske allegedly discloses the claimed generation of a preview based on the print file and configuration information, Applicants request that the Office particularly

point out and explain the portion of Adamske that allegedly discloses the use of configuration information in generating a preview and/or clarify how col. 6, lines 12-23 allegedly discloses the use of configuration information.

With respect to claim 17, Applicants initially note that the Office relies on its interpretation of Adamske with respect to claim 12 in holding that several features of claim 17 are allegedly taught or suggested by Adamske. To this extent, Applicants herein incorporate the arguments presented above with respect to claim 12. Further, Applicants have herein amended claim 17 to expressly state that the configuration information includes at least one printing option for the document. As a result, Applicants respectfully request withdrawal of the rejection of claim 17 and claims 18-19, which depend therefrom, as allegedly being obvious in view of Adamske.

With further respect to claim 17, the Office fails to show that additional features of the claimed invention are taught or suggested by Adamske. For example, the Office alleges that Adamske discloses the claimed obtaining memo information, printing a customized memo, and delivering steps. In support of its conclusion, the Office cites col. 7, lines 16-56 as allegedly disclosing these features. Applicants note that Adamske fails to include any discussion of a memo. Rather, Adamske only discusses a cover sheet, and this discussion is limited to "the print job that produces the hard copy document can also include a print out of the packaging instructions selected by the user, a cover sheet, and a shipping label (if applicable)." (col. 7, lines 40-43). To this extent, Adamske lacks any mention of obtaining memo information that is customized for a recipient at each of a plurality of delivery addresses, let alone printing and

delivering the customized memo along with the one or more copies of the document to each of the delivery addresses.

In response to similar arguments previously presented by Applicants, the Office states that "Adamske discloses that the cover sheet (memo) would include an address and the name of the actual recipient..." Applicants strenuously traverse this interpretation of Adamske. In particular, Adamske is devoid of any mention, express or implied, of the content of the cover sheet. Since, without benefit of the hindsight of Applicants' claimed invention, none of these features are taught or suggested by Adamske, Applicants respectfully request withdrawal of the rejection of claim 17 as allegedly being obvious in view of Adamske. In the alternative, should the Office maintain this rejection, Applicants request that the Office particularly point out that portion of Adamske that allegedly discloses the content of the cover sheet.

With respect to claim 20, Applicants initially note that the Office relies on its interpretation of Adamske with respect to claim 12 in holding that several features of claim 20 are allegedly taught or suggested by Adamske. To this extent, Applicants herein incorporate the arguments presented above with respect to claim 12. As a result, Applicants respectfully request withdrawal of the rejection of claim 20 and claims 21-23, which depend therefrom, as allegedly being obvious in view of Adamske.

With further respect to claim 20, the Office relies on its rejection of claim 12, which cites column 5, line 64 through column 7, line 51 of Adamske as teaching two alternative methods that, when combined, allegedly teach Applicants' claimed invention. In this rejection, Applicants respectfully submit that the Office fails to establish a *prima facie* case of obviousness since every claimed feature is not taught by Adamske. Interpreting Adamske only for the purposes of this

response, Adamske generally discusses two embodiments for a system and method for delivering an electronic document over a network.

In the first embodiment, discussed from column 4, line 61 through column 6, line 23, a user uploads an electronic document from a client computer to a web server (see, e.g., col. 5, lines 15-16). The electronic document is then converted to a portable printable format on an application translation server (col. 5, lines 18-19). In order to perform the conversion, “the application translation program [on the application translation server] houses the variety of client applications that users use to create electronic documents.” (col. 5, lines 19-21).

In the second embodiment, discussed from column 6, lines 24-57, “the client computer includes a print driver program... that is executable to convert the electronic document and provide the print preview capability prior to uploading to the web server.” (col. 6, lines 34-38). In particular, the print driver program creates a metafile from the electronic document, which provides a viewable representation of how the document will look upon printing (col. 6, lines 46-49). Subsequently, the user “sends this metafile to [the application] translation server through web server and the conversion into a printable (e.g., PostScript) version is performed as previously described.” (col. 6, lines 49-52).

In both embodiments discussed in Adamske, a printable version of the electronic document is expressly generated on an application translation server (e.g., col. 5, lines 18-19 and col. 6, lines 49-52). In sharp contrast, the claimed invention includes system software that generates a print file on a client based on the document and communicates the print file to a server. As a result, Adamske fails to disclose the claimed system software. During the telephone interview, the Examiner indicated that the phrase “print file” is being interpreted to mean any file

intended to be printed, regardless of a requirement to transform the file. In this response, Applicants have herein amended claim 20 to expressly state that the print file can be directly printed by a printer. As expressly stated in both embodiments of Adamske, a printable version of the electronic document is generated on an application translation server. Consequently, any file sent from the client in Adamske cannot be directly printed by a printer. As a result, Applicants again respectfully request withdrawal of the rejection of claim 20 and claims 21-23, which depend therefrom, as allegedly being obvious in view of Adamske.

With respect to claim 24, Applicants note that the Office relies on its interpretation of Adamske with respect to claims 12 and 20 in holding that several features of claim 24 are allegedly taught or suggested by Adamske. To this extent, Applicants herein incorporate the arguments presented above with respect to claims 12 and 20. As a result, Applicants respectfully request withdrawal of the rejection of claim 24 and claims 25-27, which depend therefrom, as allegedly being obvious in view of Adamske.

With respect to claim 29, Applicants note that the Office relies on its interpretation of Adamske with respect to claims 12 and 20 in holding that several features of claim 29 are allegedly taught or suggested by Adamske. To this extent, Applicants herein incorporate the arguments presented above with respect to claims 12 and 20. As a result, Applicants respectfully request withdrawal of the rejection of claim 29 and claim 30, which depends therefrom, as allegedly being obvious in view of Adamske.

With respect to claim 31, Applicants note that the Office relies on its interpretation of Adamske with respect to claims 17 and 20 in holding that several features of claim 31 are allegedly taught or suggested by Adamske. To this extent, Applicants herein incorporate the

arguments presented above with respect to claims 17 and 20. As a result, Applicants respectfully request withdrawal of the rejection of claim 31 as allegedly being obvious in view of Adamske.

The Office further rejects claim 28 as allegedly being unpatentable over Adamske in view of U.S. Patent No. 5,873,073 (Bresnan). Initially, the Office alleges that Adamske discloses the generation of a user interface that includes a preview area for displaying a preview that is based on a print file and configuration information for a document. However, as discussed with reference to claim 12, Adamske's preview is not based on configuration information. To the contrary, the user only selects this information after verifying the print preview (col. 6, lines 58-62).

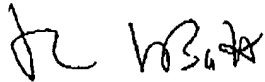
With further respect to claim 28, the Office fails to show that additional features of the claimed invention are taught or suggested by Adamske. For example, the Office alleges that Adamske discloses an "interface [that] provides a preview section and a printing options section that allows a user to provide configuration information (i.e. style options)". (Paragraph 5 of current Office Action). Applicants note that the phrase "style options" does not appear in Adamske. To this extent, Applicants submit that Adamske fails to disclose, *inter alia*, the preview area or the configuration area of the claimed invention. As a result, Applicants respectfully request withdrawal of the rejection of claim 28 as allegedly being obvious in view of Adamske. In the alternative, should the Office maintain its rejection of claim 28, Applicants request that the Office particularly point out that portion of Adamske that allegedly discloses a graphical user interface that includes a preview area, a navigation area, and a configuration area as in the claimed invention.

Finally, Applicants note that the Office continues to misinterpret the claimed subject matter of several claims. For example, in rejecting claims 17, 25, and 31, the Office states that "Adamske does not disclose that the customized memo is obtained from the client." However, Applicants note that the claimed subject matter for each of these claims does not include obtaining a customized memo from the client. In fact, claim 25 does not include any reference to a customized memo.

Applicants submit that each of the pending claims is patentable for one or more additional unique features. To this extent, Applicants do not acquiesce to the Office's interpretation of the claimed subject matter or the references used in rejecting the claimed subject matter that have not been expressly addressed herein. Additionally, Applicants do not acquiesce to the Office's combinations and modifications of the various references or the motives cited for such combinations and modifications that have not been expressly addressed herein. These features and the appropriateness of the Office's combinations and modifications have not been separately addressed herein for brevity. However, Applicants reserve the right to present such arguments in a later response should one be necessary.

In light of the above, Applicants respectfully submit that all claims are in condition for allowance. Should the Examiner require anything further to place the application in better condition for allowance, the Examiner is invited to contact Applicants' undersigned representative at the number listed below.

Respectfully submitted,



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